

REMARKS

The Office Action of October 5, 2004 has been carefully studied. The following paragraphs correspond to the order of the paragraphs of the Office Action:

Claim Objections

Claim 1 is now amended extensively and also contains a period at the end.

Claim Rejections - 35 U.S.C. 112

Claim 1 is now written so that it is clear that the substrate and the additive organic compound are not optional. Likewise, the expression "or else" no longer appears in claim 1.

Amendment to Specification

The specification is amended on page 4 at the end of lines 5 and 7 by including an epoxy group, support being found in Applicants' French priority document 02/08.343 filed July 3, 2002, which was submitted with the filing of the application on July 3, 2003. This priority document is automatically incorporated by reference by virtue of Applicants' application data sheet which mentions the priority document and further in view of 37 C.F.R. 1.57(a).

Inasmuch as this is a relatively simple amendment and since Counsel does not have another copy of the priority document and will rely on the attached published French application 2841798 which corresponds to the priority document application number 02 08343. Page 3, lines 1 and 4 clearly shows the epoxy group. Consequently, Applicants respectfully request that the requirement for a translation of the entire priority document be waived. Nevertheless, if considered necessary by the Examiner that a part of the entire priority document be translated, Counsel would appreciate receiving a telephone call so that the translation of the priority document can be provided to the Examiner as soon as possible.

Claim Rejections - 35 U.S.C. 102

Claims 1-2, and 6-20 were rejected under 35 U.S.C. 102 (b) as being anticipated by Kasztelan et al. (U.S. 6,037,300).

This rejection is no longer tenable inasmuch as claim 1 now includes the substance of original claim 3, which was not rejected over the prior art, together with an amino alcohol and an amino-alkoxysilane. Inasmuch as the reference does not mention amino alcohols or amino-alkoxy-silanes, it is apparent that the reference is no longer applicable to the presently claimed invention under 35 U.S.C. 102(b) or 35 U.S.C. 103.

Claims 1, 6-10 and 12-20 were rejected under 35 U.S.C. 102(e) as being anticipated by Harley et al. U.S. 6,436,280 B1. By inspection of this reference, it is seen that it is based on Applicants' French application 98/15596 filed December 10, 1998, which likely was published in June of 2000, thereby being a reference under 35 U.S.C. 102(b). Consequently, for the purposes of this Office Action, the Examiner may consider the U.S. patent 6,436,280 to be an English translation of the earlier French application. Thus, it is necessary for Applicants to distinguish the Harley et al. reference rather than antedate same. It is to be noted that claims 2, 3, 4 and 5 were not rejected over this reference. Consequently, since claim 1 now incorporates the amino alcohols and amino-alkoxysilanes of claim 2 and the specific amines of claim 3, the incorporation of these members into claim 1 avoids the rejection under 35 U.S.C. 102(e) or (b). Furthermore, it is respectfully submitted that there is nothing in this reference which would suggest Applicants' claim 1.

Claims 1-4, 6-20 were rejected under 35 U.S.C. 102(e) as being anticipated by Plantenga et al. U.S. 6,566,296. In the Office Action, column 3, line 53 through column 4, line 38 is indicated as a disclosure of an alcohol. However, Applicants' claims require an amino alcohol, as set forth broadly in claim 1 and specific amino alcohols as set forth in claim 4. By inspection, amino alcohols are neither described nor suggested in the broad statement of "alcohols" on column 3, line 64. Furthermore, the reference specifies alcohols in the "first group of additives as comprising at least 2 oxygen atoms" and 2-about 20 carbon atoms, preferably 2-about 10 carbon atoms (column 3, lines 65-67) and species thereof set forth on column 4, lines 13-38. On column 4, lines 13-17, it is stated that preference is given to compounds comprising at least two hydroxyl groups and about 2 to about 10 carbon atoms, and on column 4, lines 29-33, it is stated:

"Of these, ethylene glycol, diethylene glycol, triethylene glycol, tetraethylene glycol, propylene glycol, dipropylene glycol, and polyethylene glycol with a

molecular weight between about 200 and about 600 are preferred."

In addition to column 4, the Office Action points to column 5, lines 14-45 wherein there is mention of higher alcohols having at least about 12, preferably at least about 16, more preferably at least 20 carbon atoms such as dodecanol, hexadecanol, oleyl alcohol, cetyl alcohol, hexacosanol, triacontanol and octacosanol.

In view of the realistic teachings of the reference, it is respectfully submitted that it is unquestionable that the reference clearly does not anticipate Applicants' amino alcohols. Furthermore, since there is no suggestion of amino alcohols on the one hand and instead one of ordinary skill in the art is guided to the above described alcohols containing two hydroxyl groups with no amine group attached, Applicants' amino alcohols are *prima facie* unobvious over the teachings of this reference. Although the group of amino alcohols is subgeneric to "alcohols", the latter comprises an infinite number of compounds, and under such circumstances, the jurisprudence set forth in the decision *In re Baird*, Fed. Cir. 1994 (16 Fed. 2nd 380), 29 USPQ 2nd 1550 is pertinent insofar as a generic teaching without guideposts leading to a specific subgeneric group or specific species is not a proper teaching under 35 U.S.C. 103 much less 35 U.S.C. 102.

For Applicants' amine compounds, the Office Action points to column 4, lines 39 through column 5, line 8 of the reference. The compounds described therein all require "at least one carbonyl moiety" and preferably "at least two carbonyl moieties" (column 4, lines 42 and 43). In contrast, Applicants' amines do not contain any carbonyl moieties. Consequently, the reference teaches away from the specific amines mentioned in Applicants' claims.

Inasmuch as the amino-alkoxysilanes of claim 5 were not rejected over the Plantenga et al. reference, it is respectfully submitted that the group of compounds set forth in present claim 1 is neither anticipated nor made obvious by the teachings of the reference.

In view of the above remarks, it is respectfully submitted that the application is in condition for allowance, but if there are any remaining issues which can be expeditiously resolved by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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